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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,913	06/30/2000	Eduardo Cue	P2514/001580-569	1176

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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/607,913

Applicant(s)

CUE ET AL.

Examiner

James H. Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30, 32-34, 36-38 and 40-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30, 32-34, 36-38 and 40-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Prosecution History*

On 3 July 2000, applicant filed the instant application with 44 claims.

On 2 January 2003, the Examiner rejected claims 1-44.

On 27 March 2003, applicant amended claims 1, 8, 15, 22, 29, 33, 37, 41.

On 24 April 2003, the Examiner issued a ***final rejection*** of claims 1-44.

On 24 July 2003, applicant requested continued examination (***RCE***). Applicant canceled **claims 31, 35 and 39**. Applicant amended claims 1, 8, 15, 22, 29, 32, 33, 36, 37, 40, 41, 43-44.

On 13 August 2003, the Examiner rejected claims 1-30, 32-34, 36-38, 40-44.

On 13 November 2003, applicant requested reconsideration; no claims were amended.

On 29 December 2003, the Examiner issued a ***final rejection*** of claims 1-30, 32-34, 36-38 and 40-44.

On 29 March 2004, applicant filed an after-final amendment and requested reconsideration. Applicant amended claim 1, 8, 15, 22, 29, 33, 37 and 41. The amendment was not entered until 13 July 2004.

On 24 May 2004, the Examiner issued an advisory action.

On 1 June 2004, applicant requested continued examination (***RCE***).

On 13 July 2004, applicant's amendment of 29 March 2004 was entered. The Examiner rejected claims 1-30, 32-34, 36-38, 40-44 as anticipated by Dodd (6,333,849).

On 13 October 2004, applicant filed a response; no claims were amended.

On 30 November 2004, the Examiner rejected claims 1-30, 32-34, 36-38, 40-44 as unpatentable over Dodd (US 6,333,849) in view of Wish Lists.

On 13 January 2005, applicant requested reconsideration; no claims were amended.

On 30 August 2005, the Examiner issued a **final rejection** of claims 1-30, 32-34, 36-38 and 40-44 as unpatentable over Dodd (US 6,333,849) in view of Wish Lists.

On 23 November 2005, applicant requested reconsideration and filed an after-final amendment. The amendment was not entered until 3 March 2004.

On 7 December 2005, the Examiner issued an Advisory Action.

On 23 December 2005, applicant requested continued examination (**RCE**).

On 3 March 2006, the Examiner entered the amendment of 23 November 2005, whereby applicant amended claims 1, 8, 15, 22, 29, 33, 37 and 41. The Examiner rejected claims 1-30, 32-34, 36-38 and 40-44 as anticipated by Dodd, above.

On 6 July 2006, applicant requested reconsideration. No claims were amended.

#### ***Response to Request for Reconsideration***

Applicant's filing of 6 July 2006 has been entered.

Claims 1-30, 32-34, 36-38 and 40-44 are pending and will be examined.

#### ***Response to Arguments***

Applicant's arguments filed 6 July 2006 have been fully considered but they are not persuasive.

Previously, applicant argued that the claims as currently worded do not constraint the interpretation as argued by the Applicant to only sending suggestions-for purchase to a recipient. Applicant now argues,

In contrast to [Dodd] the claims define a transaction in which the person who desires to receive a product first goes to an electronic commerce site, to select the product. Once the selection has been made, an email notification is then sent to the purchaser, to allow the purchaser to view the selection and, if a roved, purchase the product that was selected by the first visitor to the site.

Conversely, in the context of the claimed subject matter, the ultimate user selects the product to be purchased, and then provides the purchaser with the option of paying for it.

In response to these comments, the Examiner notes that the above limitations are not claimed. There is no mention of "...[a person ] who **desires** to receive a product..." "...ultimate purchaser..." and "...visitor..." In addition, the Examiner notes that the final step of claim 1 refers to:

...in response to a request...from the recipient to purchase...**completing the sale**....

As previously noted, Dodd teaches that order selection is made by a gift giver (applicant's first user) such as a gift certificate and in turn the recipient upon receipt of the an email can then purchase a gift, which cost less than the order selection of a gift certificate(s). If the purchase is less than the amount of the order selection (. i.e. gift certificate), the recipient can purchase another item equivalent to the amount remaining and thereby complete the transaction.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 - 30, 32 - 34, 36 - 38 and 40 - 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Dodd (US 6,633,849 B1).

As previously noted without traverse, "the stored order data" such as "order selections and purchase information" are considered to be non-functional descriptive material (MPEP 2106). For example, online methods and systems for transmitting and receiving "stored data" such as "order selections and purchase information" such specifics of the transmitted *stored* data are given little patentable weight.

The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention from Dodd, which both disclose transmitting as well as receiving stored data. Thereby, the labels, as non-functional descriptive material is directed only to the content of the data being transmitted and received (. i.e. order selections and order purchase information - which is stored data) and does not affect either the structure or method/process of Dodd, which leaves the method and system unchanged. In this manner, the reference discloses a method and system for transmitting, receiving and responding to transmitted "stored data" by a recipient for purchase, which was old and well known at the time of the Applicant's invention.

Again, "order selections" in a reasonably broad interpretation for examination purposes included gift certificates, which can then be used as taught by Dodd to purchase items by the recipient and thereby complete a purchase transaction.

As per claim 1, Dodd discloses methods and systems for completing purchase transactions over a computer network:

receiving order selections from a computer of a first user (gift giver, for example, see also, for example, Fig. 5, steps 506-512);

saving stored order data, the stored order data including the order selections (Fig. 5, steps 514-520, for example);

generating a web page having an address and containing the order selections and order purchase information from the stored order data (as in Fig. 5, step 518);

in response to a first user (Dodd's gift giver) request, automatically producing and sending an electronic mail message having the address of the web page to a recipient (Dodd's recipients) and generated from the stored order data (see, for example, at least Fig. 5, steps 518-520);

in response to a request from the recipient, providing said web page to the recipient (see, for example, at least Col. 10, lines 9-23); and

in response to a request provided via said web page from the recipient to purchase the order selections in the stored order data, completing the sale of said order selections to said recipient.

See also at least Abstract, Col 2, lines 23 - 54, Col 3, lines 30 - 55, Col 6, lines 33 - 42, Col 10, lines 33- 43, Col 12, lines 47 - 54 and Figure 5.

**As per claim 2**, Dodd discloses producing a display of the stored order for potential purchase by the recipient (Figure 5)

**As per claim 3**, Dodd that the display-producing step comprises producing a web page display of the stored order for purchase by the recipient (Col 12, lines 48 - 52).

**As per claim 4**, Dodd discloses that in the electronic mail message includes a URL which allows for the construction of a web page displaying the stored order (Col 4, line 26 and lines 44 - 46).

**As per claim 5**, Dodd discloses that the stored order includes a single item (see at least Col 4, lines 52 -59).

**As per claim 6**, Dodd discloses that a stored order includes a main item and at least one accessory (see at least Col 4, lines 52 - 53).

**As per claim 7**, Dodd discloses that receiving the order selections includes providing an electronic display of possible selections for the user (se at least Figures 1A - 2F).

Claim 8 is rejected on the same grounds as claim 1.

Claim 9 is rejected on the same grounds as claim 2.

Claim 10 is rejected on the same grounds as claim 3.

Claim 11 is rejected on the same grounds as claim 4.

Claim 12 is rejected on the same grounds as claim 5.

Claim 13 is rejected on the same grounds as claim 6.

Claim 14 is rejected on the same grounds as claim 7.

Claim 15 is rejected on the same grounds as claim 1.

Claim 16 is rejected on the same grounds as claim 2.

Claim 17 is rejected on the same grounds as claim 3.

Claim 18 is rejected on the same grounds as claim 5.



Claim 19 is rejected on the same grounds as claim 6.

Claim 20 is rejected on the same grounds as claim 4.

Claim 21 is rejected on the same grounds as claim 7.

Claim 22 is rejected on the same grounds as claim 1.

Claim 23 is rejected on the same grounds as claim 2.

Claim 24 is rejected on the same grounds as claim 3.

Claim 25 is rejected on the same grounds as claim 5.

Claim 26 is rejected on the same grounds as claim 6.

Claim 27 is rejected on the same grounds as claim 7.

Claim 28 is rejected on the same grounds as claim 4.

Claim 29 is rejected on the same grounds as claim 1.

***As per claim 30***, Dodd discloses that first and second order selections are selected from a web page from an electronic commerce site (see at least Abstract and Col 1, lines 34 - 51)

Claim 31 was cancelled on 24 July 2003..

***As per claim 32***, Dodd discloses that display of a web page for the first or second orders includes a link to a display of the items of the first order and a display of the items of the second order (see at least Figures 1A-2F).

Claim 33 is rejected on the same grounds as claim 1.

Claim 34 is rejected on the same grounds as claim 30.

Claim 35 was cancelled on 24 July 2003..

Claim 36 is rejected on the same grounds as claim 32.

Claim 37 is rejected on the same grounds as claim 1.

Claim 38 is rejected on the same grounds as claim 30.

Claim 39 was cancelled on 24 July 2003..

Claim 40 is rejected on the same grounds as claim 32.

Claim 41 is rejected on the same grounds as claim 1.

Claim 42 is rejected on the same grounds as claim 30.

***As per claim 43***, Dodd discloses that the display of the first and second stored orders comprise a web page (see at least Figures 1A-2F).

Claim 44 is rejected on the same grounds as claim 32.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
26 September 2006

*James Zurita*  
*Primary Examiner*